

REMARKS

At the time of the Final Office Action dated June 15, 2004, claims 1-3 were pending and rejected in this application.

CLAIMS 1-3 ARE REJECTED UNDER SUBSECTION (F) OF 35 U.S.C. § 102 BASED UPON JP

2002-330820 (HEREINAFTER JP '820)

CLAIM 1 IS ALSO REJECTED UNDER SUBSECTION (F) OF 35 U.S.C. § 102 BASED UPON JP

2003-038248 (HEREINAFTER JP '248)

On page two of the Office Action, the Examiner cited subsection (f) of 35 U.S.C. § 102, and essentially asserted that "[the inventor] did not himself invent the subject matter sought to be patented." This rejection is respectfully traversed.

A discussion of 35 U.S.C. § 102(f) is found in M.P.E.P. § 2137. As discussed therein, the Examiner must provide evidence that the invention was completely derived from another and the conception of the invention was communicated to the inventor. The Examiner, however, has provided no evidence that the claimed invention was derived from another beyond citing JP '820 and JP '248, which were filed after the priority date of the present application and published after the filing date of the present application. The Examiner has also not explained what in JP '820 and JP '248 has led the Examiner to believe that the conception of the invention was communicated to the Applicants. Applicants, therefore, submit that the Examiner has failed to establish that Applicants did not invent the subject matter sought to be invented, as required by subsection (f) of 35 U.S.C. § 102. Thus, Applicants respectfully solicit withdrawal of the

imposed rejections of claims 1-3 and 1 under subsection (f) of 35 U.S.C. § 102 respectively based upon JP '820 and JP '248.

CLAIMS 1-3 ARE REJECTED UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON EP 0393723 (HEREINAFTER EP '723) IN VIEW OF JP 11-137336 (HEREINAFTER JP '336) AND FURTHER IN VIEW OF JP 63188628 (HEREINAFTER JP '628) OR JP 63027411 (HEREINAFTER JP '411)

In the statement of the rejection, the Examiner relied upon JP '628 or JP '411 "to disclose that hydroxyapatite is used in cosmetic product to absorb oxidized lipids." The Examiner then asserted that one having ordinary skill in the art would have been motivated to modify the combination of EP '723 and JP '336 in view of either JP '628 or JP '411 to arrive at the claimed invention. This rejection is respectfully traversed.

With regard to the requisite motivation to modify the combination of EP '723 and JP '336 in view of either JP '628 or JP '411, the Examiner asserted:

However, the prior art amply suggests the same as it is known in the art to use papers containing hydroxyapatite and talc as absorbants, [sic] papers containing talc are known to be used for absorbing oil from the skin and that hydroxyapatite [sic] is used in cosmetic products to absorb oxidized lipids. As such, one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation that a paper containing hydroxyapatite and talc would be suitable for absorbing oxidized sebum from the skin.

Applicants also note the Examiner's statement on page four of the Office Action, in which the Examiner asserted:

Therefore, the claimed invention, as a whole, would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

With regard to the last assertion, Applicants note that the mere identification of claim features in disparate references does not establish the requisite realistic motivation to support the ultimate legal conclusion of obviousness under 35 U.S.C. § 103.¹ As a general matter, it is recognized that "virtually all [inventions] are combinations of old elements."² Thus, the Examiner's assertion that "every element of the invention has been collectively taught" alone does not establish the requisite motivation to modify the applied prior art in the manner suggested by the Examiner.

Notwithstanding that the Examiner has pointed to certain references to teach that hydroxyapatite can be used to absorb lipids, the Examiner's rejection lacks the requisite motivation to modify the combination of EP '723 and JP '336 in view of either JP '628 or JP '411. The motivation to modify the prior art must come from the prior art.³ The Examiner, however, has failed to identify where either JP '628 or JP '411 teaches modifying EP '723 and JP '336, either alone or in combination. Instead, the Examiner appears to rely on an "obvious to try" argument, which has long been held as insufficient to establish a motivation to combine.⁴

¹ Grain Processing Corp. v. American-Maize Products Co., 840 F.2d 902, 5 USPQ2d 1788 (Fed. Cir. 1988).

² In re Rouffet, 149 F.3d 1350, 47 USPQ2d 1453 (Fed. Cir. 1998) (quoting Environmental Designs, Ltd. v. Union Oil, 713 F.2d 693, 218 USPQ 865 (Fed. Cir. 1993)).

³ There must be a teaching or suggestion within the prior art, within the nature of the problem to be solved, or within the general knowledge of a person of ordinary skill in the field of the invention, to look to particular sources, to select particular elements, and to combine them as combined by the inventor. See Ruiz v. A.B. Chance Co., 234 F.3d 654, 665, 57 USPQ2d 1161, 1167 (Fed. Cir. 2000); ATD Corp., 159 F.3d at 546, 48 USPQ2d at 1329; Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc., 21 F.3d 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1994) ("When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination.").

⁴ Obvious to try is not the standard. In re O'Farrell, 853 F.2d 894, 7 USPQ2d 1673 (Fed. Cir. 1988); In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Dow Chemical Co., 837 F.2d 469, 5 USPQ2d 1529 (Fed. Cir. 1988).

Furthermore, Applicants note that one having ordinary skill in the art would not have looked to either JP '628 or JP '411 to modify the combination of EP '723 and JP '336. JP '411, entitled "Dust Preparation for Skin External Use," discloses a powdery preparation that is applied to the skin to "prevent or improve skin roughness." Instead, JP '411 discloses a product that is not part of a paper. JP '411 also does not disclose that hydroxyapatite would be effective in adsorbing lipids when used as a filler in a sebum absorbing paper. Thus, one having ordinary skill in the art would not look to JP '411 to modify the primary references (i.e., EP '723 and JP '336) since the teachings of JP '411 would not be recognized as applicable to the cosmetic-type papers disclosed by the primary references.

Similar to JP '411, as discussed above, JP '628 is also not related to the cosmetic-type papers disclosed by the primary references. Instead, JP '628, entitled "Drug for Skin External Use," is directed to a blend of "a hydroxyapatite powder with antiphlogistics and/or keratin release agents." As described in the abstract, the product can be in the form of "a shape of cream, ointment, lotion, tonic, powder." However, JP '628 does not state that the hydroxyapatite could be used as a filler in a cosmetic-type paper, such as that disclosed by EP '723 and JP '336, to absorb lipids. Thus, one having ordinary skill in the art would not look to JP '628 to modify the primary references since the teachings of JP '628 would not be recognized as applicable to the cosmetic-type papers disclosed by the primary references.

Thus, for the reasons stated above, Applicants respectfully submit that one having ordinary skill in the art would not have been motivated to modify the combination of EP '723 and JP '336 in view of either JP '628 or JP '411 so as to arrive at the claimed invention. Applicants, therefore,

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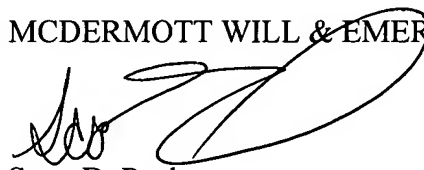
respectfully solicit withdrawal of the imposed rejection of claims 1-3 under 35 U.S.C. § 103 for obviousness based upon EP '723 in view of JP '336, JP '628, and JP '411.

Applicants have made every effort to present claims which distinguish over the prior art, and it is believed that all claims are in condition for allowance. However, Applicants invite the Examiner to call the undersigned if it is believed that a telephonic interview would expedite the prosecution of the application to an allowance. Accordingly, and in view of the foregoing remarks, Applicants hereby respectfully request reconsideration and prompt allowance of the pending claims.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417, and please credit any excess fees to such deposit account.

Respectfully submitted,

MCDERMOTT WILL & EMERY LLP

A handwritten signature in black ink, appearing to read 'Scott D. Paul', is written over the firm name.

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